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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.				
09/710,181	11/10/2000	Steven D. Jensen	7678.350.2	4245				
22913	7590	08/25/2004	<table border="1"> <tr> <td colspan="2">EXAMINER</td> </tr> <tr> <td colspan="2">PRYOR, ALTON NATHANIEL</td> </tr> </table>		EXAMINER		PRYOR, ALTON NATHANIEL	
EXAMINER								
PRYOR, ALTON NATHANIEL								
WORKMAN NYDEGGER (F/K/A WORKMAN NYDEGGER & SEELEY) 60 EAST SOUTH TEMPLE 1000 EAGLE GATE TOWER SALT LAKE CITY, UT 84111			<table border="1"> <tr> <td>ART UNIT</td> <td>PAPER NUMBER</td> </tr> <tr> <td>1616</td> <td></td> </tr> </table>		ART UNIT	PAPER NUMBER	1616	
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1616								

DATE MAILED: 08/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/710,181	JENSEN ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Alton N. Pryor	1616	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on 27 May 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☐ Claim(s) 41-86 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 41-86 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### DETAILED ACTION

Applicant's arguments filed 5/27/04 have been fully considered but they are not persuasive. See arguments below.

I. Rejection of claims 41,42,46-85 under 35 USC 102(b) as being anticipated by USPN 5,851,512 will be maintained for reason on record and reason as follows. New claim 86 is added to this rejection.

Applicant has amended all claims to recite "the bleaching composition is formulated so that KNO<sub>3</sub> does not destabilize said bleaching agent" Applicant states the USPN 6,368,576 is incorporated by reference in instant application. Applicant recites that USPN '576 recites "a stable, one part nitrate contained therein does not destabilize the dental bleaching agent". Applicant argues that since instant application incorporates USPN '576 by reference; the composition instantly claimed is formulated so that said KNO<sub>3</sub> does not destabilize said bleaching agent. Applicant argues that USPN '512 does not teach a composition as such. In fact, Applicant argues that USPN '512 discloses that KNO<sub>3</sub> destabilize peroxides such that peroxides can only be mixed with KNO<sub>3</sub> destabilizing composition just before treatment. Examiner disagrees with Applicant. Examiner argues that USPN '512 teaches or covers the instant concentration range (0.05-1%) of KNO<sub>3</sub>. It is inherent that the composition at instant concentration of ingredients would exhibit the same properties (wherein, the KNO<sub>3</sub> does not destabilize the bleaching agent, i.e. maintain a one-par composition) as in instant composition having the same concentration of ingredients.

II. Obviousness type Double Patenting rejection of claims 43-45 over USPN '512 in view of 5,985,249 will be maintained for reason of record and reason as follows.

Applicant reiterates that USPN '512 explicitly teaches that KNO<sub>3</sub> destabilizes peroxide bleaching agent and that peroxide can not be mixed together except shortly before use. Examiner restates that USPN '512 teaches or covers the instant concentration range (0.05-1%) of KNO<sub>3</sub>. It is inherent that the composition at instant concentration of ingredients would exhibit the same properties (wherein, the KNO<sub>3</sub> does not destabilize the bleaching agent, i.e. maintain a one-par composition) as in instant composition having the same concentration of ingredients.

III. Obviousness type Double Patenting Rejection of claims 72-85 over USPN 6,306,370 and claims 41,42,46-55,58-69,72-85 over USPN 6,309,625 will be maintained for reason on record and reason as follows. See arguments in sections I and II above. New claim 86 is added to the rejections.

IV. Rejection of new claims 41,42,46-85 under 35 USC 102(b) as being anticipated by prior art on record will be maintained for reason on record and reason as follows. New claim 86 is added to this rejection.

Applicant argues that prior art makes claims to an invention comprising 0.1 – 10% potassium nitrate; whereas, the instant invention claims 0.05 – 1% potassium nitrate. Applicant argues that prior art does not make claim to bleaching agent; whereas, instant application makes claim to a bleaching agent. Applicant argues that prior art teaches that higher concentrations in the 0.1 – 10% range increases desensitization; whereas, instant invention shows that lower concentrations of bleaching agent (0.5 %)

gives better desensitizing results than higher concentrations of the desensitizing agent (3% and above). Applicant argues that composition comprising a) 0 % potassium nitrate, 10% carbamide peroxide b) 0.5% potassium nitrate, 10.5% carbamide peroxide are more effective in desensitizing teeth than composition comprising 3% potassium nitrate and 10% carbamide peroxide. Examiner argues that the instant range of 0.05 – 1% potassium nitrate falls within the prior art range of 0.1 to 10% potassium nitrate. Therefore, Examiner concludes that prior art anticipates the instant invention. The prior art teaches the presence of bleaching agents (carbamide peroxide) in the prior art invention. See column 9 lines 18-27. Examiner agrees with Applicant's results. However, Examiner argues that claims are for broader than the unexpected results provided by the Applicant.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

***Telephonic Inquiry***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alton N. Pryor whose telephone number is 571-272-0621. The examiner can normally be reached on 8:00 a.m. - 4:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz can be reached on 571-272-0887. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Alton Pryor  
Primary Examiner  
AU 616